

Page 7 of 13  
Application. No. 10/678,046  
Amendment B

### **REMARKS**

Responsive to the Office Action mailed September 14, 2005, Applicants provide the following. Claims 1, 4, 12, and 16 have been amended. Claim 21 has been added without adding new matter. Claim 20 has been canceled, because the limitations of claim 20 were substantially amended into claim 16. Twenty (20) claims remain pending in the application: Claims 1-19 and 21. Reconsideration of claims 1-19 and 21 in view of the amendments above and remarks below is respectfully requested.

By way of this amendment, Applicants have made a diligent effort to place the claims in condition for allowance. However, should there remain any outstanding issues that require adverse action, it is respectfully requested that the Examiner telephone the undersigned at (858) 552-1311 so that such issues may be resolved as expeditiously as possible.

### **Claim Rejections - 35 U.S.C. §102**

1. Claims 1, 4, 5-7, 16, 19 and 20 stand rejected under 35 U.S.C. § 102(a), as being anticipated by U.S. Patent Publication No. 2004/0236843 (Wing et al.).

Applicants have amended claims 1 and 16, and Applicants respectfully submit that amended claims 1 and 16, for example, are not anticipated by the Wing reference. More specifically, amended claims 1 and 16 variously recite, in part, "determining whether the electronic device comprises a diagnostic controller" and "remotely receiving a diagnostic controller over the distributed network when the electronic device does not comprise a diagnostic controller." Support for the amendment is provided throughout the application as filed, for example on at least page 11, lines 16-25. The Wing reference describes downloading a client application to a computer to be diagnosed. (See Wing, paragraphs 0009, 0081, 0153, and 0176.) However, Wing requires download of the client application at least after client registration. Wing fails to describe conditionally downloading the client application

432221\_2

Page 8 of 13  
Application No. 10/678,046  
Amendment B

depending upon whether the device to be diagnosed already includes the client application. Therefore, amended claims 1 and 16 are not anticipated by the Wing reference, because Wing fails to teach at least each element of amended claims 1 and 16.

Furthermore, dependent claims 4, 5-7, and 19 are not anticipated by the Wing reference. Dependent claims 4 and 5-7, which depend from amended claim 1, are not anticipated by the Wing reference at least due to their dependence on amended claim 1. Dependent claim 19, which depends from amended claim 16, is also not anticipated by the Wing reference at least due to its dependence on amended claim 16.

#### Claim Rejections - 35 U.S.C. §103

2. Claims 2, 8 and 17 stand rejected under 35 U.S.C. § 103(a), as being unpatentable over U.S. Patent Publication No. 2004/0236843 (Wing et al.) of in view of U.S. Patent No. 6,397,245 (Johnson et al.).

Applicants have amended claims 1 and 16, and the applied references fail to teach at least each element of the amended claims 1 and 16. As demonstrated above, Wing fails to describe at least conditioning the receipt of a diagnostic controller upon whether an electronic device to be diagnosed already includes a diagnostic controller. Furthermore, Johnson fails to teach or describe at least remotely receiving a diagnostic controller. The control logic described in Johnson is resident on the server and a diagnostic controller is never remotely received over the distributed network. (See Johnson, FIGS. 6A, 6B and 7.) Therefore, amended claims 1 and 16 are not obvious in light of the combined references for at least the reasons provided. Furthermore, dependent claims 2 and 8, which depend from claim 1, and dependent claim 17, which depends from independent claim 16, are also not obvious in light of the combined references at least due to their dependence on independent claims 1 and 16.

Further with regard to at least claims 2 and 17, the applied references fail to teach at least each element of claims 2 and 17. Claims 2 and 17 variously recite, in

432221\_2

Page 9 of 13  
Application. No. 10/678,046  
Amendment B

part, "receiving the plurality of scripts includes receiving at least one web page having the plurality of scripts" (emphasis added). The Examiner relies on Johnson to teach the receipt of scripts via a web page. (Office Action, page 6, paragraph 16.) However, Johnson describes a diagnostic web page containing links to server-side Active Server Page (ASP) scripts that perform various diagnostics. (See Johnson, col. 6, lines 5-14; col. 3, lines 26-36; and FIGS. 6A, 6B and 7, reference no. 132.) ASP scripts reside on a web server and perform various server-side functions, such as, for example, dynamic web page generation or execution of other business logic on the web server. ASP scripts are not, however, incorporated into a webpage communicated to a client as variously recited in claim 2 and 17. Moreover, incorporating a link to a script into a webpage is not the same as incorporating a script itself into a web page. The link to a server-side script in Johnson merely provides a means for routing a request to the server to initiate executing said script on the server. Server-side execution of a server-side script is in direct contrast to the local receipt of a web page incorporating at least one script and locally executing the at least one script as recited in claims 2 and 17. Therefore, the combination of applied references fails to teach all of the claim limitations of claims 2 and claim 17, and thus, claims 2 and 17 are not obvious in light of the combined references for at least the reasons provided.

With regard to at least claim 8, the applied references fail to teach or describe at least "incorporating the plurality of the scripts into a web page" and "the communicating of the plurality of the scripts includes communicating the web page over the distributed network" as recited in claim 8. The arguments presented above with respect to amended claims 2 and 17 similarly apply to claim 8. The Johnson patent describes the use of server-side scripts that are neither incorporated into a web page nor transmitted over a distributed network. (See Johnson, col. 6, lines 5-14.) Therefore, the combination of applied references fails to teach all of the claim limitations of claim 8,

432221\_2

Page 10 of 13  
Application No. 10/678,046  
Amendment B

and thus, claim 8 is not obvious in light of the combined references for at least the reasons provided.

3. Claims 3 and 18 stand rejected under 35 U.S.C. § 103(a), as being unpatentable over U.S. Patent Publication No. 2004/0236843 (Wing et al.) in view of Official Notice.

Applicants respectfully traverse the official notice. The Wing reference does not provide motivation to incorporate the decryption of at least a portion of the scripts as recited in claims 3 and 18. The encryption of scripts for diagnostic testing is not well known in the art. Therefore, official notice cannot be taken.

4. Claims 9-15 stand rejected under 35 U.S.C. § 103(a), as being unpatentable over U.S. Patent Publication No. 2004/0236843 (Wing et al.) in view of U.S. Patent Publication No. 2002/0165952 (Sewell et al.).

Dependent claims 9-11, which depend from amended claim 1, are not obvious in light of the applied references at least due to their dependence on independent claim 1. Amended claim 1 is not obvious in light of the combination of the Wing and Sewell references. As demonstrated above, Wing fails to describe at least conditioning the receipt of a diagnostic controller upon whether an electronic device to be diagnosed already includes a diagnostic controller. Furthermore, Sewell fails to teach or describe at least the remotely receiving a diagnostic controller. Sewell describes diagnostic devices "used to perform tests on a malfunctioning item" (see Sewell, paragraph 0040 and FIGS. 1-3). However, Sewell fails to teach or describe at least a diagnostic device remotely receiving a diagnostic controller over the distributed network. Therefore, the applied references fail to teach at least each element of amended claim 1, and thus amended claim 1 is not obvious in light of the applied

432221\_2

Page 11 of 13  
Application. No. 10/678,046  
Amendment B

references. Furthermore, dependent claims 9-11 are also not obvious in light of the applied references at least due to their dependence on amended claim 1.

With regard to independent claim 12, Applicants have amended claim 12. Amended claim 12, recites, in part, a "diagnostic controller ... wherein the diagnostic controller is transmitted across the distributed network when a determination whether the electronic device includes a diagnostic controller indicates that the electronic device does not include a diagnostic controller." Neither Wing nor Sewell teaches at least conditionally receiving a diagnostic controller from a diagnostic server dependent upon whether an electronic device to be tested includes a built-in diagnostic controller. Therefore, the applied references fail to teach at least each element of the amended claim 12, and thus, amended claim 12 is not obvious in light of the combined references. Furthermore, dependent claims 13-15 are also not obvious in light of the combined references at least due to their dependence on amended claim 12.

With regard to claim 14, the applied references fail to teach or describe at least a "diagnostic controller ... maintained within the electronic device, wherein the electronic device provides processing capabilities for the diagnostic controller..." as recited in claim 14 (emphasis added). More specifically, the Examiner relies on Sewell to teach a "'diagnostic processor' that can be maintained either in computer host system used to control diagnostic device or incorporated within diagnostic devices themselves" emphasis added (Office Action, paragraph 29, emphasis added). Sewell, however, fails to teach or describe at least a diagnostic controller maintained within the electronic device to be diagnosed as recited in claim 14. The diagnostic devices described in Sewell are "used to perform tests on malfunctioning items" (see Sewell, paragraph 0020). Sewell fails to describe the diagnostic devices as also being the electronic devices to be diagnosed. Therefore, the applied references fail to teach or describe at least each element of claim 14, and thus, claim 14 is not obvious in light of the applied references.

432221\_2

Page 12 of 13  
Application No. 10/678,046  
Amendment B

**New Claims**

4. Newly submitted claim 21 is believed to be allowable because it is directed to that which is not shown or suggested in the applied references. Support for the new claim is provided in the application as filed at least on page 12, line 26 – 29 and FIG. 7, reference no. 406.

432221\_2

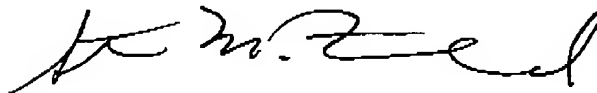
Page 13 of 13  
Application No. 10/678,046  
Amendment B

**CONCLUSION**

Applicants submit that the above amendments and remarks place the pending claims in a condition for allowance. Therefore, a Notice of Allowance is respectfully requested.

Respectfully submitted,

Dated: December 14, 2005



Steven M. Freeland  
Reg. No. 42,555  
Attorney for Applicants  
(858) 552-1311

Address all correspondence to:  
FITCH, EVEN, TABIN & FLANNERY  
Thomas F. Lebens  
120 So. LaSalle Street, Ste. 1600  
Chicago, IL 60603

Direct telephone inquiries to:  
Thomas F. Lebens  
(858) 552-1311  
San Diego, California Office of  
FITCH, EVEN, TABIN & FLANNERY

432221\_2